

U.S.S.N. 10/614,456

-2-

GKNG 1165 PUS

IN THE DRAWINGS:

Please substitute the three (3) pages of formal drawings submitted herewith, one sheet containing Figures 1a, 1b, 2a, 2b and 2c; one sheet containing Figures 3a and 3b; and one sheet containing Figures 3c and 4 in place of the originally filed drawing sheets containing the same Figures. These drawing sheets have been submitted for purposes of clarity only. No new matter has been added.

U.S.S.N. 10/614,456

-7-

GKNG 1165 PUS

REMARKS

Claims 1-20 are pending in the application. Claims 1-4, 10-16 and 18-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris, U.S. Patent No. 3,013,920 in view of Douglass, U.S. Patent No. 6,205,907. Claims 5 and 6 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris and Douglass, in further view of Chilton, U.S. Patent No. 2,178,953. Finally, claims 5-9 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Harris and Douglass, in further view of Voss, U.S. Patent No. 3,797,816.

The Examiner's comments have been carefully considered by Applicant, and Applicant respectfully submits that the case, as presently amended, is in a condition for allowance. In this regard, the Applicant has amended the claims herein to remove reference numerals for purposes of clarity. The amendments were not made for any reasons related to patentability.

Applicant traverses the rejections under 35 U.S.C. §103 and submits that a *prima facie* case of obviousness has not been established. The rejections of obviousness must be based upon objective evidence of record, and must be supported by particular findings as to why a skilled artisan, with no knowledge of the claimed invention, would have selected the specific components for combination in the manner claimed. Thus, in order for any prior art references themselves to be validly combined for use in an obviousness rejection under 35 U.S.C. §103, the references, or some other piece of prior art, must suggest that they be combined. *In Re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). That is, the suggestion to combine the references must not come from the applicant's proposed invention itself. *Orthopaedic Equipment Co. vs. United States*, 217 USPQ 193, 199 (Fed. Cir. 1983). Thus, as the Examiner is aware, in order to establish a *prima facie* case of obviousness, it is necessary to present evidence in the form of some teaching, suggestion, incentive, or motivation in the applied prior art that one of ordinary skill in the art would have been lead to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex Parte Levengood*, 28 USPQ2d 1300-1301, 1302 (BPAI 1993). ("That which is within the

U.S.S.N. 10/614,456

-8-

GKNG 1165 PUS

capabilities of one skilled in the art is not synonymous with obviousness.") The focus must remain on what the prior art suggested to one of skill in the art at the time the invention was made.

Critically, none of the prior art references relied upon in the Office Action disclose or suggest a method of producing a roll boot for a constant velocity universal joint from an injection molded elastomer wherein the injection molded basic member includes a cylindrical portion; the basic member is turned completely inside out; and, thereafter, a portion of the basic member is folded over to produce a finished roll boot. Further, none of the references relied upon are directed toward Applicant's problem of relieving stresses in the roll wall of the boot for a constant velocity universal joint.

In particular, the Harris reference is directed toward a method of making a flexible diaphragm. The process starts with a strip of corded fabric which is wound along a substantially helical path about a mandrel. The resulting tubular form is then expanded to a symmetrical shape. Thereafter, one end of the product is folded over and drawn along the remainder of the product to obtain a two-ply device. At this point, the product is only at an intermediate stage – it is not a finished product. Further, at this point, the product is only a two-ply corded material product. It is not rubber, it is not elastomer, it is not waterproof. Moreover, it is not intended to be used in this form. Rather, the product is then shaped on another form and equipped with bead wire bundles or solid metal bead wires in an outwardly extending resilient lip at its widened end. The process then continues by placing the product in another apparatus to be molded and cured with rubber to give it resiliency and water-resilient properties.

Similarly, the Douglass reference is only cited to show that injection molding is a known technique. Applicant is not claiming all forms of injection molding. However, it is worth noting that Douglass is not directed toward injection molding of rolling boots for constant velocity joints either.

U.S.S.N. 10/614,456

-9-

GKNG 1165 PUS

Accordingly, Applicant submits that no *prima facie* case of obviousness exists as Harris and Douglass, either alone or in combination, fail to disclose or suggest at least the following features of Applicant's invention:

- (a) completely turning the product inside out as an intermediate process step;
- (b) injection molding an elastomer basic member comprising a cylindrical portion; or
- (c) folding back the widened portion of the basic member to produce a finished roll boot ready for assembling and use within a constant velocity universal joint.

Each of these elements form part of independent claims 1, 2, 17 and 18. Thus, for at least these same reasons, dependent claims 3-16, 19 and 20 are also non-obviousness.

Further, as mentioned above, Applicant submits that one of skill in the art would not be motivated to modify the Harris reference as the Office Action proposes, because the Harris reference is directed toward a different problem. Indeed, neither Harris, Douglass, Chilton nor Voss are directed toward relieving stresses in the roll wall of a roll boot for a constant velocity universal joint. Thus, to say that the missing claimed features of Harris come from the nature of the problem to be solved, evidences improper hindsight reconstruction because the Office Action fails to show that this problem is identified in any of the relied upon references. *In Re Zurko*, 111 F.3d 887, 890 (Fed. Cir. 1997). Thus, although the Office Action purports to recognize the need to identify a suggestion or motivation to modify the prior art, Applicant submits that the Office Action improperly relies upon the claimed invention as a template for modifying the prior art. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). ("It is impermissible to use the patent itself as the source of suggestion.")

The Applicant therefore submits that the present claims are allowable because the prior art relied upon does not disclose or suggest each and every feature of Applicant's claimed invention. Further, no valid reason has been shown why one of ordinary skill in the art would modify the references to arrive at the claimed invention particularly because the references disclose different solutions to different problems

U.S.S.N. 10/614,456

-10-

GKNG 1165 PUS

than those addressed by the present application. Accordingly, Applicant submits that the rejections under 35 U.S.C. §103 should be withdrawn, and a Notice of Allowance indicating the allowability of claims 1-20 should be issued. The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 223-9500 if any unresolved matters remain with respect to this Response.

Respectfully submitted,

ARTZ & ARTZ, P.C.



Robert P. Renke, Reg. No. 40,783
28333 Telegraph Road, Suite 250
Southfield, MI 48034
(248) 223-9500

Dated: September 21, 2005